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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,325	07/23/2003	Douglas G. Guenther	WT0115	7745

7590 02/16/2005

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EXAMINER
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WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/625,325	<b>Applicant(s)</b> GUENTHER ET AL.	
	<b>Examiner</b> Steven Wong	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.  
 2a) ☐ This action is FINAL.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 51-64 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-14 and 51-64 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3711

1. This supplemental action is required merely to include the U.S. Patent No. 6,767,300 in the double patenting rejection.

***Election/Restrictions***

1. Applicant's election of Figure 12 is noted. The applicant also states that Figures 13-21 are closely related to Figure 12 and merely illustrate other forms of the pebbled projections. The applicant states that claim 1 is generic to all claims. Applicant's remarks are persuasive. Figures 12-21 shall be examined together as they merely relate to various forms of the pebbled projections. Claims 1-14 and 51-64 are directed to the elected invention.

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the lacing with the longitudinally segments having a first shaped projection and the transversely extending segments with a second shaped projection (claim 11) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

Art Unit: 3711

renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claim 14 is objected to because of the following informalities: the language "the outer layer" lacks a proper antecedent basis. It appears that claim 14 should depend from claim 13, since claim 13 recites the outer layer and structure therefore. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5, 7, 9, 10 and 51-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931). Regarding claim 1, Horkan discloses a football construction including laces that have hook or loop fasteners thereon for improving the gripping of the ball. Note column 2, lines 51 and 52 stating that the fastener merely replaces the conventional lacing.

Martin discloses that it is well known in the art of game balls to provide projections on the surface of the ball in order to improve its grippability. It would have been obvious to one of ordinary skill in the art to replace the hook fastener as taught by Horkan with a plurality of

Art Unit: 3711

projections in order to provide an alternative textured surface that also improves the gripping of the football and does not rely on the use of the glove.

Regarding claims 2 and 3, the projections of Martin are described as pebbles.

Regarding claims 5 and 7, Martin teaches arranging equal sized pebbles in an evenly spaced pattern. It would have been obvious to one of ordinary skill in the art to place the equal sized pebbles in an evenly spaced pattern on the laces in order to provide an aesthetically pleasing design for the ball.

Regarding claims 9 and 10, note Figure 9 of Martin showing the height and width for the projections. The claimed aspect ratio is considered to be obvious given the teachings of Martin and the lack of a showing of the criticality for the claimed aspect ratio by a new and unexpected result obtained therefrom.

Regarding claims 51-64, note column 3, lines 12-17 of Martin stating that other shapes may also be used as projections. It would have been obvious to one of ordinary skill in the art to provide the laces of Horkan with the shapes taught by Martin order to provide an alternative textured surface that also improves the gripping of the football and does not rely on the use of the glove. Further, any other shapes claimed by applicant and not disclosed by Martin (oval, irregular) are considered to be obvious given the teachings of Martin and the lack of a showing of the criticality for the claimed shapes by a new and unexpected result obtained therefrom.

5. Claims 4, 8, 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931) and Feeney (6,283,881). Regarding claim 4, Feeney discloses a game ball construction including a plurality of differently shaped projections on the surface of the ball (note Figure 8 and column 5, lines 16-30). It would have been obvious

Art Unit: 3711

to one of ordinary skill in the art to provide differently shaped projections on the laces of the ball of Horkan as modified by Martin in order to arrange a particular design for the ball while still improving the grip.

Regarding claim 8, the projections of Feeney are of varying sizes.

Regarding claim 11, Horkan teaches lacing that provides a plurality of longitudinally extending segments and a plurality of transversely extending segments. It would have been obvious to one of ordinary skill in the art to apply a first shaped projection to the longitudinal segments and a second shape to the transverse segments as the applicant has not disclosed that this particular arrangement is for any particular purpose or solves any stated problem and it appears that the arrangement of Horkan as modified by Martin and Feeney would accomplish similar purposes.

Regarding claim 12, Horkan teaches hook fasteners along the entire surface of the lacing. To replace the hook fasteners with the projections of Martin would obviously also place projections along the entire surface of the lacing.

Regarding claim 14, it would have been obvious to one of ordinary skill in the art to form the lacing of Horkan from a polyurethane material in order to take advantage of that material's well known physical properties.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (6,629,902) in view of Martin (4,570,931) and Finley (4,991,842). Finley reveals a grip enhanced basketball where the projections are randomly placed. It would have been obvious to one of ordinary skill in the art to randomly place the projections on the laces of the ball of Horkan as modified by Martin in order to provide a particular design pattern for the laces.

***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 or claim 1 of U.S.

Patent No. 6,767,300 or the claim of D457,208 or the claim of D480,774. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims a football with lacing having a pebble-like surface.

9. Claims 5, 7, 9, 10 and 51-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 or claim 1 of U.S. Patent No. 6,767,300 or the claim of D457,208 or the claim of D480,774 in view of Martin (4,570,931). It would have been obvious to one of ordinary skill in the art to form the projections of Patent '902 with the shapes and arrangement of Martin order to an alternative shape and arrangement for the textured surface of the lacing.

10. Claims 4, 8, 11, 12 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 or claim 1 of U.S. Patent No. 6,767,300 or the claim of D457,208 or the claim of

Art Unit: 3711

D480,774 in view of Martin (4,570,931) and Feeney (6,283,881). It would have been obvious to one of ordinary skill in the art to provide the lacing of Patent '902 with differently shaped projections in order to arrange a particular design for the ball while still improving the grip.

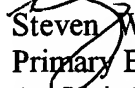
11. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 or claim 1 of U.S. Patent No. 6,767,300 or the claim of D457,208 or the claim of D480,774 in view of Finley (4,991,842). It would have been obvious to one of ordinary skill in the art to provide the surface of the laces of Patent '902 with randomly spaced projections in order to provide a particular design to the laces.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW



Application/Control Number: 10/625,325

Page 8

Art Unit: 3711

February 10, 2005